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GROUP 1746
Docket No.: 0465-1094P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ki Chul CHA

Application No.: 10/720,056 Confirmation No.: 4192

Filed: November 25, 2003 Art Unit: 1746

For: DEVICE AND METHOD FOR CONTROLLING DRYING OF LAUNDRY IN DRUM TYPE WASHING MACHINE Examiner: J. M. Heckert

PRE-APPEAL BRIEF CONFERENCE REQUEST

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests a pre-appeal conference with respect to the Office Action dated February 6, 2008, in which pending claims 1-3, 5-7 and 10 are finally rejected. Claims 1 and 7 are independent. A Notice of Appeal is being filed herewith.

Claims 1-3, 5 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by 6,247,339 to Kenjo et al. ("Kenjo"). The final Office Action states that Kenjo discloses all of the structural components of Applicant's device, and is believed to be capable of operating in the same manner. The rejection gives no patentable weight to any of the functional language in claims 1-3, 5 and 6. Instead, it relies on four case law citations for the proposition that the manner in which an apparatus operates is not germane to the issue of patentability of the

apparatus, and relies on two case law decisions for the proposition that apparatus claims cover what a device is, not what a device does.

This rejection is improper for several reasons. Firstly, Kenjo fails to disclose the subject matter positively recited in claim 1, including in the "wherein" clause of claim 1, i.e., fails to disclose that the claimed controlling part detects if one of preset rotation speeds is the same as a maximum value of a detected rotation speed and fails to determine a drying time period relevant to the preset rotation speed which is the same as a maximum value of the detected rotation speed, as the drying cycle time period. Kenjo certainly does not contain this disclosure inasmuch as its load determination method is limited to the extent that it "involves, e.g., transition of rotating speed of motor 5 during the given time based on the signals from the detector 17 . . ." (col. 4, lines 35-39).

Secondly, Applicants respectfully submit that this "wherein" clause is entitled to be given patentable weight. The "wherein" clause of claim 1 positively recites relationships between the structural elements of claim 1 that are material to patentability of claim 1 that are entitled to be given patentable weight and that are not disclosed by Kenjo. Also, Applicant refers the Examiner to *Akamai Technologies Inc., v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186 (Fed. Cir. 2003), where patentable weight was given to the "wherein" clause without question. Similarly, in *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002), the court held that the wherein clause limits the subject matter in issue. Applicants respectfully submit that the wherein clause of claim 1 positively recites features that are not otherwise inherent in the claim, are used to patentably define the invention, and must be given patentable weight.

Thirdly, Applicant also respectfully submits that all of the functional language in the body of the claims has to be given patentable weight. In this regard, MPEP §2173.05(g) clearly states that a functional limitation must be evaluated and considered, just like any limitation of the claim. Additionally, the Federal Circuit has clearly determined that functional language phrases, e.g., "for extending into said security slot . . ." are limitations that have to be given patentable weight in evaluating a claim. See, in this regard, *ACCO Brands, Inc. v. Micro Security Devices, Inc.*, 68 USPQ2d 1526 (Fed. Cir. 2003).

Fourthly, Applicant respectfully submits that the four case law citations relied on by the Examiner do not support the proposition that functional claim language in Applicant's claims reciting the manner in which an apparatus operates does not have to be given patentable weight. The "*Wikdahl*" decision and the "*McCullough*" decision actually dealt with claims in which only the claim preamble used functional language, as contrasted with Applicant's claims which also recite functional language elements in the body of the claims, and are clearly governed by the aforementioned *ACCO Brands, Inc.* case law, and the principles and case law discussed in MPEP §2173.05(g). The "*Casey*" decision, which dealt both with claim preamble and functional language in the body of *Casey's* claim 1, is easily distinguished from the present claims because both the Board and the Court gave the structural and functional aspects of the claim patentable weight and indicated that these features were met by the applied art, as noted on page 238 of that decision. Furthermore, in the "*Finsterwalder*" decision, the Court clearly stated that it "gives all words in the claims their broadest reasonable interpretation." So, *Finsterwalder* is completely inapposite to the principles for which it was cited. *Finsterwalder* actually gave patentable weight to functional language in the claims in issue.

Additionally, the "*Hewlett-Packard*" decision actually gave patentable weight to the "wherein" clause language of "wherein the rough surface on one of said at least one powered drive and idler wheels of the first drive means has a random pattern, size, and height of rough spots." Thus, the "*Hewlett-Packard*" decision actually supports giving patentable weight to Applicant's "wherein" clause.

Furthermore, the "*Demaco Co.*" decision concerned a claim in which the only functional language in the claim, which was "for paving," was given patentable weight. In fact, all limitations of the claim were given patentable weight. The case actually focused on whether to consider commercial success of the claimed invention, and did so.

Thus, the case law decisions which serve as the basis for this rejection actually do not support the decision to refuse to give patentable weight to the functional language of claims 1-3, 5 and 6, whereas the current Federal Circuit case law decisions, which properly addresses this issue, reject the Examiner's position. Thus, the rejection of claims 1-3, 5 and 6 is improper and must be reversed.

Claims 7 and 10 stand rejected under 35 USC §103(a) as unpatentable over Kenjo in view of U.S. Patent 6,006,445 to Large. The rejection admits that Kenjo does not disclose a heater/blower unit for air-drying, and turns to Large to disclose a heater/blower unit in a washer/dryer combo, concluding that it would be obvious to modify Kenjo to include a heater/blower unit to dry laundry. The rejection further concludes that this combination is believed to be capable of operating the steps of claims 7 and 10, which are regarded as intended uses as they impart no structure.

This rejection is improper because (1) neither Kenjo nor Large provide preset rotation speeds, or detect if one of a preset rotation speed is the same as a maximum value of a detected rotation speed and fails to determine a drying time period relevant to the preset rotation speed which is the same as a maximum value of the detected rotation speed, as the drying cycle time period, (2) the final Office Action does not explain where these positively claimed features are found in Large, and (3) the final Office Action improperly gives these positively recited features no patentable weight, for reasons discussed above.

Accordingly, the final rejection of claims 7 and 10 is improper and should be withdrawn.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: June 6, 2008

Respectfully submitted,

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